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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,999	12/31/2001	Shanmugasundaram Ravikumar	ARC920020121US1	2455

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EXAMINER

PITARO, RYAN F

ART UNIT	PAPER NUMBER
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2174

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/035,999	Applicant(s) RAVIKUMAR ET AL.	
	Examiner Ryan F Pitaro	Art Unit 2174	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>01072002</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-17 have been examined.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 15 contains the trademark/trade name TrackPoint®. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a software application for use in a phone and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1,2,6,7,8,10,15,16,17 are rejected under 35 U.S.C. 102(b) as being anticipated by Sasaki et al ("Sasaki", US 6,122,005).

As per independent claim 1, Sasaki discloses generating a pull-down menu in a graphical user interface (Column 9 lines 11-20); and moving labeled items in said pull-down menu representing choices such that relative positions of said items correspond to relative user preferences (Column 10 lines 1-10).

As per claim 2, which is dependent on claim 1, Sasaki discloses the method comprising the step of deleting said items representing unacceptable user choices (Column 12 lines 40-45).

As per independent claim 6, Sasaki discloses a system for specifying user preferences, comprising: a computing device generating a graphical user interface (Column 4 lines 36-45); a pull-down menu in said graphical user interface including labeled items (Column 9 lines 11-20) representing choices available to a user (Column 9 lines 17-21); and an input device enabling said user to arrange said items such that relative positions of said items correspond to relative user preferences (Column 10 lines 37-40; *cameras selected by mouse and the items are arranged in order of frequency*).

As per claim 7, which is dependent on claim 6, Sasaki discloses the system wherein the computing device is at least one of: a personal computer (Column 4 lines

36-45; wherein all of the components working together form a personal computer), a cellular telephone, a personal digital assistant, a pager.

As per claim 8, which is dependent on claim 6, Sasaki discloses the system wherein the pull-down menu is persistent (Column 10 lines 8-15; *wherein persistent is defined as remaining after a period of time*).

As per claim 10, which is dependent on claim 6, Sasaki discloses the system wherein pull-down menu is a vertical list of buttons (Figure 5).

As per claim 15, which is dependent on claim 6, Sasaki discloses the system where the input device is at least one of: a mouse (Figure 1 item 28), a TrackPoint® device, a trackball, a keyboard (Figure 1 item 26), a stylus, a touch-sensitive screen, a speech analyzer.

Claims 16 and 17 are individually similar in scope to that of claim 1, and are therefore rejected under similar rationale.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3-5,9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki et al ("Sasaki", US 6,122,005) in view of Windows NT ("WINNT", Windows NT screen dumps).

As per claim 3, which is dependent on claim 1, Sasaki fails to distinctly point out deleting said items representing uninteresting choices. However, WINNT teaches deleting the items representing uninteresting user choices (Figures 4a-4b; *Winzip*). Therefore it would have been obvious to an artisan at the time of the invention to combine Sasaki's method with the teaching of WINNT. Motivation to do so would have been to provide only the items on the menu that the user will utilize, making the selection smaller and cutting the search time.

As per claim 4, which is dependent on claim 1, Sasaki fails to distinctly point out a cut-off bar. However, WINNT teaches limiting the number of items by using a cut-off bar (Figure 2 item 30). Therefore it would have been obvious to an artisan at the time of the invention to combine Sasaki's method with the teaching of WINNT. Motivation to do so would have been to only allow a certain number of items to cut the search time of scrolling through too many items in the menu.

As per claim 5, which is dependent on claim 1, Sasaki fails to distinctly point out clicking and dragging. However, WINNT teaches a moving step comprises substeps of clicking and dragging (Figure 3a-3b). Therefore it would have been obvious to an artisan at the time of the invention to combine Sasaki's method with the teaching of WINNT. Motivation to do so would have been to provide a visual way of moving items so that the user can see which place of the order to put the item.

As per claim 9, which is dependent on claim 6, Sasaki fails to distinctly point out items that form a hierarchy. However, WINNT teaches a system wherein the items form a hierarchy (Figure 2). Therefore it would have been obvious to an artisan at the time of

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the invention to combine Sasaki's system with the teaching of WINNT. Motivation to do so would have been to provide a simple way of organizing the items so that they can easily be displayed.

9. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki et al ("Sasaki", US 6,122,005) in view of JavaScript Buttons ("JavaScript Buttons", <http://www.jsr.communitech.net/buttons.htm>).

As per claim 11, which is dependent on claim 6, Sasaki fails to disclose a horizontal list of buttons. However, JavaScript Buttons teaches a system where the menu is a horizontal list of buttons. Therefore it would have been obvious to an artisan at the time of the invention to combine the system of Sasaki with the teaching of JavaScript Buttons. Motivation to do so would have been to provide another way of presenting the information while utilizing the horizontal space on the interface, while taking up less space on the screen.

As per claim 12, which is dependent on claim 6, Sasaki fails to disclose the menu implemented in HTML or JavaScript. However, JavaScript Buttons teaches a menu implemented in JavaScript (Page 1). Therefore it would have been obvious to an artisan at the time of the invention to combine the system of Sasaki with the teaching of JavaScript Buttons. Motivation to do so would have been to produce interactive menus to make the interface more appealing and useable.

10. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki et al ("Sasaki", US 6,122,005) in view of ViaJCart™ ("ViaJCart", User Manual).

As per claim 13, which is dependent on claim 6, Sasaki fails to disclose items in the menu describing e-commerce transactions. However, ViaJCart teaches choices describing variables defining electronic commerce transactions (Page 3, Figure 3). Therefore it would have been obvious to an artisan at the time of the invention to combine the system of Sasaki with the teaching of ViaJCart. Motivation to do so would have been to extend menu capabilities to include e-commerce transactions so that users can easily choose items from the menu.

As per claim 14, which is dependent on claim 13, Sasaki-ViaJCart discloses the system wherein the electronic commerce transactions include at least one of: making travel reservations, shopping online (ViaJCart, Page 1 Figure 1), specifying shipping options (Page 6 Figure 5), choosing a restaurant, selecting a vendor, providing marketing data, specifying employment interest.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US005914714A teaches moving buttons on a horizontal menu.
- US006121968A teaches hiding unused menu items.
- US 20020167548A1 teaches a customizable drop down menu.
- US 5950000 teaches pull down menus tracking recent actions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan F Pitaro whose telephone number is 571-272-

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4071. The examiner can normally be reached on 7:00am - 4:30pm Monday through Thursday, and on alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid can be reached on 571-272-4063. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ryan Pitaro
Patent Examiner
Art Unit 2174

RFP

Kristine Kincaid
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